

Applicant respectfully traverses this restriction requirement for the reasons provided in the following remarks.

REMARKS

In general, there are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required.

M.P.E.P. § 803. As discussed below, the March 16, 2011 Office Action fails to properly establish that the claims of groups I and II are independent or distinct. Further, a serious burden would not be placed on the Examiner if the restriction between these groups of claims is not required.

I. The Claims of Groups I and II Have Not Been Established to be Independent or Distinct

First, the Office Action has failed to establish that the claims of groups I and II are independent or distinct. The Examiner asserts that groups I and II are related as subcombinations disclosed as usable together in a single combination. Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants. MPEP 806.05(d). This standard, however, has not been met, as discussed below.

In explaining the reasoning for the restriction, the Examiner asserts that “subcombination II has separate utility such as making the applied postage indicia look like a hand applied postage stamp and having at least two separate postage labels that total at least the determined postage amount.” Item 2 on page 2 of the Office Action. Applicant believes that the Examiner mistakenly referred to subcombination II in this statement, and instead intended to refer to certain limitations that are found in some of the claims of Group I. For instance, claims 42 and 50 mention the appearance of a mail piece (or mail item) comprising a postage stamp (or mail stamp) that was obtained from a delivery service and was applied by hand. None of the claims identified in Group II include a mention of such appearance that a postage stamp (or mail stamp) was applied by hand.

Thus, the Examiner appears to contend that there are portions of the two claim groups that do not overlap in scope that do not overlap in scope. For instance, the Examiner contends that the limitations of:

1) the appearance that a postage stamp or mail stamp was applied by hand and
2) having at least two separate postage labels that total at least the determined postage amount
are present in certain claims of Group I, but are not present in the claims of Group II. Again, the Examiner incorrectly identifies “subcombination II” as reciting these limitations, but apparently intended to contend that the claims of Group I recited the limitations.

However, the Examiner has ignored portions within these groups that clearly do overlap in scope. As such, the Examiner cannot assert that there is NO OVERLAP in scope between groups I and II.

For example, independent claim 24 of Group II recites:

A method for creating valid postage labels for use on mail pieces, comprising:
calculating a postage amount due for each of the mail pieces;
creating valid postage labels associated with each of the mail pieces before the mail pieces arrive at a location comprising a postage indicium applicator;
printing, by a printer on blank labels, the valid postage labels comprising postage indicia corresponding to the postage amount calculated for the mail pieces;
applying, by said high-speed letter processing system, the valid postage labels to the associated mail pieces wherein no human readable portions of said valid postage labels display permit information.

Group I includes many limitations that overlap with those of claim 24.

For instance, independent claim 42 of Group I recites “creating a machine generated postage stamp, by a high speed mail item computer processing system” (compare to the limitation “creating valid postage labels associated with each of the mail pieces” recited by claim 24).

Additionally, independent claim 42 of Group I further recites “printing, by a printer, said machine generated postage stamp including a postage indicium ... wherein the postage

indicia is associated with a particular one of the plurality of mail pieces and bears at least the determined postage amount" (compare to the limitation "printing, by a printer on blank labels, the valid postage labels comprising postage indicia corresponding to the postage amount calculated for the mail pieces" of claim 24).

Additionally, independent claim 42 of Group I further recites "affixing the machine generated postage stamp to the mail pieces" (compare to the limitation "applying, by said high-speed letter processing system, the valid postage labels to the associated mail pieces" of claim 24).

Additionally, dependent claim 45 of Group I depends from independent claim 42 and further recites "wherein no human readable portions of said valid postage labels display permit information" (compare to the limitation "wherein no human readable portions of said valid postage labels display permit information" of claim 24).

Applicant notes that the above limitation recited in claims 24 and 45 appears to be the primary basis for requiring restriction. For instance, the Examiner indicates that the claims of Group I are "drawn to determining and applying postage indicia", while the claims of Group II are "drawn to determining and applying postage indicia wherein no human readable portions of the valid postage labels display permit information" (emphasis added). Item 1 of page 2 of the Office Action. However, as noted above, the limitation that "no human readable portions of said valid postage labels display permit information" is found in **both** Groups I and II. That is, claim 45 of Group I recites this limitation, as does claim 24 of Group II. Accordingly, the very basis for the differing classifications of the claim groups asserted in the Office Action appears to be improper and unsupported.

In addition, many other limitations having overlapping scope are present in the claims of Groups I and II. For instance, dependent claim 31 of Group II depends from claim 24 and recites "wherein each of the postage indicia are associated with a mail piece that is designated for a particular recipient, and wherein the each of the valid postage labels comprise an image, wherein the image is selected based upon one or more characteristics of the associated particular recipient". Similarly, claim 47 of Group I recites "wherein at least one of the two

postage stamps comprise an image selected based upon one or more characteristics of a recipient of the particular mail piece.”

As another example, dependent claim 32 of Group II depends from claim 31 and further recites “wherein the one or more characteristics of the recipient are selected from the group consisting of:

- the recipient’s age;
- the recipient’s sex;
- the recipient’s occupation; and
- the recipient’s location.”

Similarly, claim 14 of Group I depends from claim 47 and recites “wherein the one or more characteristics of the recipient are selected from the group consisting of:

- the recipient’s age;
- the recipient’s sex;
- the recipient’s occupation; and
- the recipient’s location.”

As seen above, there is clearly an overlap in scope between the groups set forth by the Examiner. Thus, the requirements for restricting the claims as set forth in MPEP 806.05(d) here are not met because the Examiner cannot properly establish that there is NO OVERLAP in scope between groups I and II. Accordingly Applicant respectfully requests that the restriction be withdrawn.

While the scope of the claims in Groups I and II is not identical, their scope nevertheless “overlaps” as discussed above. It would be unreasonable to interpret the “overlap” requirement set forth in MPEP 806.05(d) as requiring identical scope at least because to achieve identical scope would require the claims to be impermissibly duplicative.

As discussed above, the scope of the claims in Group I do indeed overlap with that of Group II (although their scope is not identical). Therefore, Applicant respectfully submits that distinctness as between claim Groups I and II has not been properly established for the above reasons, and thus the restriction between Groups I and II should be withdrawn.

B. No SERIOUS BURDEN For Continued Examination of Groups I and II

Additionally, if “the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803. The Examiner has failed to adequately establish that such a SERIOUS burden would arise in the present case if the restriction is not made.

First, Applicant respectfully notes that the present application has undergone many previous searches/examinations and Office Actions. While Applicant’s previous response amended some of the claims and added some new claims, most of the limitations recited in the currently-pending claims have been searched/examined.

Indeed, the Office Action of September 29, 2010 addressed virtually all of the limitations presented in the currently-pending claims, and even indicated claims 42, 43, and 45 as allowable and further indicated that claim 44 would be allowable if rewritten in independent form. Applicant’s attorney, Jody Bishop, left a telephonic voicemail message for the Examiner on April 11, 2011 inquiring as to whether those claims were still allowable (as the Restriction Requirement fails to so indicate that status), and the Examiner left Applicant’s attorney a return voicemail message on April 12, 2011 confirming that the previously allowed claims remain allowed.

Thus, a serious burden would not arise in maintaining those claims (and other claims having the limitations that are grouped with these allowed claims) in the present application with the other claims. That is, **maintaining the allowed claims of Group I (which is not elected by the provisional election made herein) with the provisionally-elected claims of Group II would appear to add no further burden, as these claims have already been fully searched and examined and deemed allowable (see the Office Action of September 29, 2010).**

Further, the claims examined in the Office Action of September 29, 2010 included the limitations of:

1) the appearance that a postage stamp or mail stamp was applied by hand (*see e.g.*, claims 9, 24, 42 as pending after Applicant’s Amendment of July 12, 2010), and

2) having at least two separate postage labels that total at least the determined postage amount (*see e.g.*, claim 42 as pending after Applicant's Amendment of July 12, 2010).

Thus, the above-noted limitations were examined in the Office Action of September 29, 2010, along with the many other limitations that were presented by the claims pending as of Applicant's Amendment of July 12, 2010. Therefore, maintaining the claims in the present application would not lead to a serious burden on the Examiner, as most of the limitations recited in the claims have been the subject of one or more of the numerous previous Office Actions.

The Examiner fails to provide sufficient reasoning regarding why a serious burden would arise if the restriction were not required in the present case. Instead, the Office Action merely includes a conclusory statement that "there would be a serious search and/or examination burden if restriction were not required because ... Group II includes elements that are not present in claims in Group I." Item 3 on page 3 of the Office Action. **However, the Examiner has not identified which, if any, of the limitations have not been previously searched/examined and addressed in the earlier Office Actions, such as that of September 29, 2010.** So, while one claim Groups I and II may include limitations that are not present in the other group, it is not clear that any such limitations have not been previously addressed by other Office Actions, and thus it is certainly not clear that there would be a SERIOUS burden if the restriction were not required in the present case, particularly considering the large degree of overlap in limitations between the claim Groups as discussed above.

Accordingly, Applicant respectfully submits that the Examiner has failed to establish that a SERIOUS burden exists if the claims of group II are not restricted from those of group I, and therefore the restriction requirement as between groups I and II should be withdrawn.

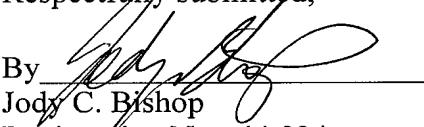
Conclusion

In view of the above, Applicant respectfully traverses the restriction requirement of the March 16, 2011 Office Action as improper. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding Restriction Requirement for the reasons discussed above.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P022US/10303187 from which the undersigned is authorized to draw.

Dated: April 18, 2011

Respectfully submitted,

By 
Jody C. Bishop
Registration No.: 44,034
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8007
(214) 855-8200 (Fax)
Attorney for Applicant